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ROBERTS MLOTKOWSKI SAFRAN & COLE, P.C.
Intellectual Property Department
P.O. Box 10064
MCLEAN, VA 22102-8064

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| EXAMINER |
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KARDOS, NEIL R

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/643,987
Filing Date: August 20, 2003
Appellant(s): AHERN ET AL.

Andrew M. Calderon
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed on July 1, 2010 appealing from the Office action mailed March 2, 2010.

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(1) Real Party in Interest

The examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The following is a list of claims that are rejected and pending in the application:

1-8, 10, 32-41, and 52-63.

Examiner notes that the claims are misnumbered in the Claims Appendix of the Appeal Brief. There are two claims numbered as claim 32, and there are two claims numbered as claim 52. The Claims Appendix is also missing claims 41 and 63. In this Examiner's Answer, claim 32 refers to the first-numbered claim 32, and claims 33-41 refer to the second-numbered claim 32 through claim 40, respectively. Furthermore, in this Examiner's Answer, claim 52 refers to the first-numbered claim 52, and claims 53-63 refer to the second-numbered claim 52 through claim 62, respectively.

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(4) Status of Amendments After Final

The examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief.

(5) Summary of Claimed Subject Matter

The examiner has no comment on the summary of claimed subject matter contained in the brief.

(6) Grounds of Rejection to be Reviewed on Appeal

The examiner has no comment on the appellant's statement of the grounds of rejection to be reviewed on appeal. Every ground of rejection set forth in the Office action from which the appeal is taken (as modified by any advisory actions) is being maintained by the examiner except for the grounds of rejection (if any) listed under the subheading "WITHDRAWN REJECTIONS." New grounds of rejection (if any) are provided under the subheading "NEW GROUNDS OF REJECTION."

WITHDRAWN REJECTIONS

The following grounds of rejection are not presented for review on appeal because they have been withdrawn by the examiner: The section 112 rejection set forth in the final Office action dated March 2, 2010 was withdrawn in the advisory action dated May 17, 2010.

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(7) Claims Appendix

Examiner notes that the claims are misnumbered in the Claims Appendix of the Appeal Brief. There are two claims numbered as claim 32, and there are two claims numbered as claim 52. The Claims Appendix is also missing claims 41 and 63. In this Examiner's Answer, claim 32 refers to the first-numbered claim 32, and claims 33-41 refer to the second-numbered claim 32 through claim 40, respectively. Furthermore, in this Examiner's Answer, claim 52 refers to the first-numbered claim 52, and claims 53-63 refer to the second-numbered claim 52 through claim 62, respectively.

(8) Evidence Relied Upon

The following evidence is relied upon by the examiner in the rejection of the claims under appeal:

- Richard D. Buchanan and Richard Mark Soley, "Aligning Enterprise Architecture and IT Investments with Corporate Goals," OMG and Metagroup Whitepaper (2002).
- Ulrich Frank, "Multi-Perspective Enterprise Modeling (MEMO) – Conceptual Framework and Modeling Languages," Proceedings of the 35th Annual Hawaii International Conference on System Sciences (2002).
- Golightly (US 2003/0046130)
- Ricardo Chalmeta, et al., "References Architectures for Enterprise Integration," 57 Journal of Systems and Software 175-91 (2001).

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(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-8, 10, 32-41, and 52-62 are rejected under 35 U.S.C. 103(a) as being unpatentable over Buchanan, "Aligning Enterprise Architecture and IT Investments with Corporate Goals" in view of Frank, "Multi-Perspective Enterprise Modeling (MEMO) – Conceptual Framework and Modeling Languages," and further in view of Golightly (US 2003/0046130).

Claim 1: Buchanan discloses a method for managing and tracking changes, the method comprising the steps of:

- defining at least one customer requirement for an enhancement to an enterprise architecture (see page 1, paragraph 1, disclosing delivering and linking new enterprise solutions; page 1, paragraph 3, disclosing corporate goals and priorities; page 2, paragraph 1, disclosing identifying opportunities; page 5, paragraph 2, disclosing identifying opportunities);
- identifying at least one capability to provide the enhancement to the enterprise architecture (see page 1, paragraph 3, disclosing aligning IT projects with

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corporate goals and priorities; page 2, paragraph 1, disclosing identifying opportunities and recommending appropriate investments based on the opportunities; page 2, paragraph 2, disclosing aligning IT with corporate goals; figure 3, depicting aligning systems with processes and goals; page 5, paragraph 3, disclosing identifying which assets will engage in processes to support business strategy; page 5, paragraph 4; page 6, paragraphs 3-4);

- estimating at least one of a revenue increase and a cost saving associated with the at least one capability (see page 3, paragraph 3, disclosing value as financial efficiency, which includes reducing costs or enhancing financial yield);
- determining a value provided by the at least one capability based upon an implementation cost and the at least one of a revenue increase and the cost saving (see page 3, paragraph 3, disclosing value as a reflection of financial efficiency and business effectiveness);
- using a database to store a hierarchical relationship of a goal, the value, the at least one capability, and a resource, the hierarchical relationship having a plurality of levels with one or more dynamic links that differ between the plurality of levels with one or more dynamic links that differ between the plurality of levels (see page 2, paragraph 3, disclosing a hierarchy that extends from the business strategy level to the IT implementation level and allows the organization to align business goals and IT investment plans; figure 3, depicting a business process that is linked to overall strategy and is supported by an application and technology infrastructure within a value chain; page 6, paragraphs 3-4, disclosing linking

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technology to program/project initiatives and defining relationships between processes and infrastructure; figures 4 and 5, depicting linking different levels of the enterprise architecture);

- wherein the method further comprises at least one of:
- capturing and displaying current resources of the organization and how they relate to the organizations' mission in real-time (see page 5: paragraph 3: "an enterprise architecture . . . identifies (in a very targeted, pragmatic way) which assets will engage in what processes in support of the forward business strategy"; page 5: paragraph 4: "An enterprise business architecture is a business vision-driven process, that decomposes the enterprise's business strategies, the assets and processes required to execute them, as well as their impact on business functions"; see also Frank: figure 3, depicting a resource (insurance broker) and how it relates to an "Operations" activity, which is one step in the organization's value chain; Frank: figure 4, depicting resources that perform activities in an activity group, which drives value for the organization and is part of the organization's strategy), directly tracking which specific resources directly support the capabilities (see id.), and illustrating and quantifying a value of transforming an enterprise business model of the organization from a current "as-is" state to a proposed "to-be" business model (see page 7: "Any change in principles or in models results in an analysis of the gap between what already exists and what is called for by the changed strategy and the redefined enterprise architecture. Based on values and priorities assigned to requirements and principles, IT is in a position to create a set

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of priorities for modifications and to plan changes. . . . IT investments are made according to objective measures of business strategic value and in accordance with a long term plan for infrastructure and architecture development."; see also page 5, disclosing current and future state models; page 2: paragraph 3, disclosing identifying the gaps between the current state and the future architecture; page 3, disclosing using value measures to guide decisions);

- defining the goal as a corporate directive establishing a final end point of an enterprise change (see page 2: paragraph 3, disclosing bridging the gap between the current and future states; page 5: paragraphs 3-4; page 6: last paragraph, disclosing a goal of changing aspects of the business; furthermore, this is an understood definition of a goal—a goal is some result or achievement toward which effort (change) is directed), defining the value as a customer value (see page 3: paragraph 3, disclosing value measures, including value to a customer; page 7: paragraph 1, disclosing prioritizing based on value; see also Frank: page 4, column 1 and figure 4, disclosing value chains, which by their definition are those activities that provide value to a customer), the at least one capability is a strategic capability that represents a critical function that the organization must be capable of performing to insure delivery of the customer value (see at least page 5: paragraphs 3-4, disclosing strategies; see also Frank: figure 4, depicting a value chain as well as activities that must be carried out to achieve the value; see also Frank: figure 3, depicting the same), and defining the resource as a physical component that must be present and supports the at least one capability (see page

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5: paragraph 3-4, disclosing business strategies as well as the assets and processes that are required to execute them, and identifying assets that will engage in processes in support of a forward business strategy; see also Frank: figures 3 and 4, disclosing resources that perform activities that support a value chain and a generic strategy);

Buchanan does not explicitly disclose the remainder of claim limitations. Frank discloses:

- displaying the hierarchical relationship between the goal, the value which is associated with the goal, the at least one capability which represents critical functions for ensuring delivery of the value, and one or more resources which enables the at least one capability (see figure 4, depicting a display of "Generic Strategy" linked to "ValueChain" linked to "Activity" linked to "Resource"; page 2, column 2, paragraph 1, disclosing a "permanent representation of all relevant aspects on an enterprise (strategy, business processes, organizational structure, business entities, business rule, etc.)"; figure 1, depicting goals, processes, structure, and resources; page 4, section 3.3, paragraph 1, disclosing "means to navigate through the views of an enterprise model on various levels of detail");
- using a system implemented on a computer platform to partition information relevant to enterprise decision making for evolutionary change by creating categories of information and relating these categories to one another, the information being defined by at least one of the value, the at least one capability,

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and operational resources (see figure 4, described above; page 3, section 3.1, disclosing partitioning the information);

- using an automated system to manage the categories of information (see page 4: section 3.3, disclosing computer tools used to manage the categories).

Buchanan and Frank are both directed to enterprise modeling. Buchanan discloses requirements for achieving business goals, capabilities to achieve those requirements, and a value associated with the capabilities, as well as storing a relationship between these items. Frank discloses displaying the relationships between these items and managing the items on a computer system. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the system disclosed by Frank to store, display, and manage the hierarchical items disclosed by Buchanan. One of ordinary skill in the art would have been motivated to do so for the benefit of efficiencies gained through the visualization of the model (see Frank, page 2, section 2, paragraph 2, disclosing that visualization of models contributes to a better understanding).

Buchanan and Frank do not explicitly disclose capturing and linking process measurements from one or more external modeling tools to the database to allow process performance to be accessed by the system. Golightly discloses this limitation (see paragraph 77, disclosing receiving process data; paragraph 83-85, disclosing receiving performance data values and models; paragraphs 105-107, disclosing external inputs; paragraphs 140 and 143, disclosing production performance). Buchanan, Frank, and Golightly are all directed to frameworks for modeling a business. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine aspects of Golightly's architecture with aspects of the

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architectures of Buchanan and Frank. This combination of known elements retains the functionality of the separate elements and produces a result that would be predictable to one of ordinary skill in the art. Furthermore, One of ordinary skill in the art would have been motivated to add the performance measurements of Golightly to the architectures of Buchanan and Frank for the benefit of efficiencies gained by tracking performance and using results to make better decisions.

Claim 2: Buchanan discloses:

- mapping the at least one customer requirement to the at least one capability (see page 1, paragraph 3, disclosing aligning IT projects with corporate goals and priorities; page 2, paragraph 1, disclosing identifying opportunities and recommending appropriate investments based on the opportunities; page 2, paragraph 2, disclosing aligning IT with corporate goals; figure 3, depicting aligning systems with processes and goals; page 5, paragraph 3, disclosing identifying which assets will engage in processes to support business strategy; page 5, paragraph 4; page 6, paragraphs 3-4; Examiner's note: Frank also teaches this limitation – see at least figure 4); and
- comparing the value provided by the at least one capability with another value provided by at least one other capability and determining which capability provides optimum value (see page 7, paragraphs 1-2, disclosing that investments are made according to objective measure of business strategic value; Examiner's

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note: Golightly also teaches this limitation – see paragraphs 77, 86, 115, 129, and 133, as well as figure 6).

Claim 3: Buchanan discloses wherein the identifying step includes identifying one or more strategic resources to support the at least one capability (see sections cited in the rejection of claim 1; Buchanan discloses IT infrastructure for supporting corporate goals; Examiner's note: Frank also discloses this limitation – see at least figure 4).

Claim 4: Buchanan discloses wherein the identifying at least on capability step includes identifying at least one of a business process (see figure 3), a personnel skill/competency, a physical entity (see figure 3, disclosing technology infrastructure), an information technology (see figure 3, disclosing applications and infrastructure), a system component (see id.), and an infrastructure component (see id.).

Claim 5: Buchanan discloses assigning a weight to the one or more strategic resources and prioritizing the one or more strategic resources based on the assigned weight (see page 7, paragraphs 1-2, disclosing assigning priorities for investments; Examiner's note: Golightly also teaches this limitation – see paragraphs 25, 53-54, and 158-159). Furthermore, Examiner takes Official Notice that it was well-known in the art at the time the invention was made to assign weights and prioritize elements in view of those weights.

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Claim 6: Buchanan discloses assigning outcome based performance metrics to the one or more strategic resources (see page 3, paragraph 3, disclosing objective measure that capture aspects of value; page 7, paragraphs 1-2, disclosing objective measures of business value; Examiner's note: Golightly also discloses this limitation – see paragraphs 85, 103, 140, and 143).

Claim 7: Buchanan and Frank do not explicitly disclose the limitations of this claim. Golightly discloses implementing and tracking the one or more strategic resources based on the outcome based performance metrics (see ¶ 85, disclosing providing performance information; ¶ 103, disclosing throughput and production rates of machinery; ¶ 140, disclosing production attributes such as cost, quality, yield, and capacity; ¶ 143, disclosing production rate, cycle times, quality summaries, and running production tallies). It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the business management techniques of Golightly into the framework disclosed by Buchanan and Frank in order to track performance of implemented projects. One of ordinary skill in the art would have been motivated to do so for the benefit of accurately and efficiently determining the impact of implemented projects.

Claim 8: Buchanan discloses assigning a weight to the at least one capability and prioritizing the at least one capability based on the assigned weight (see page 7, paragraphs 1-2, disclosing assigning priorities for investments; Examiner's note: Golightly also teaches this limitation – see paragraphs 25, 53-54, and 158-159). Furthermore, Examiner takes Official

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Notice that it was well-known in the art at the time the invention was made to assign weights and prioritize elements in view of those weights.

Claim 10: Buchanan discloses assigning outcome based performance metrics to the at least one capability (see page 3, paragraph 3, disclosing objective measure that capture aspects of value; page 7, paragraphs 1-2, disclosing objective measures of business value; Examiner's note: Golightly also discloses this limitation – see paragraphs 85, 103, 140, and 143).

Buchanan and Frank do not explicitly disclose tracking the at least one capability based on the outcome based performance metrics. Golightly discloses this limitation (see ¶ 85, disclosing providing performance information; ¶ 103, disclosing throughput and production rates of machinery; ¶ 140, disclosing production attributes such as cost, quality, yield, and capacity; ¶ 143, disclosing production rate, cycle times, quality summaries, and running production tallies). It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the business management techniques of Golightly into the framework disclosed by Buchanan and Frank in order to track performance of implemented projects. One of ordinary skill in the art would have been motivated to do so for the benefit of accurately and efficiently determining the impact of implemented projects.

Claims 32-41 and 52: Claims 32-41 and 52 are substantially similar to claims 1-8 and 10, and are rejected under similar rationale.

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Claim 53: The cited references do not explicitly disclose wherein the at least one customer requirement is defined in response to a request by a customer. However, the cited references at least suggest this limitation because they discuss corporate goals, and corporate goals are a reflection of customer value. Furthermore, Examiner takes Official Notice that it was well-known in the art at the time the invention was made to define customer requirements in response to a request by a customer (e.g. through the use of customer surveys or feedback). It would have been obvious to one of ordinary skill in the art at the time the invention was made to define the requirements of Buchanan in response to a customer request, as is well-known in the art. One of ordinary skill in the art would have been motivated to do so for the benefit of value gained through responding to customers.

Claim 54: Buchanan discloses wherein the value is monetary or in terms of strategic business worth (see page 3, paragraph 3).

Claim 55: Buchanan and Frank do not explicitly disclose wherein the outcome based performance metrics are defined and tested by conducting facilitates working sessions or building simulation models. Golightly teaches this limitation (see Golightly generally; the disclosure is directed to predictive models). It would have been obvious to one of ordinary skill in the art at the time the invention was made to perform the simulations of Golightly when analyzing the impact of changes to the enterprise frameworks of Buchanan and Frank. One of ordinary skill in the art would have been motivated to do so for the benefit of a more efficient and accurate way to measure the impact of changes.

Claim 56: Buchanan and Frank do not explicitly disclose wherein the estimates are at least one of entered, recorded, or modified as additional real performance information is observed. Golightly discloses this limitation (see at least ¶ 83). It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the estimates taught by Golightly when analyzing the impact of proposed to the enterprise frameworks of Buchanan and Frank. One of ordinary skill in the art would have been motivated to do so for the benefit of a more accurate indication of the impact that a change will have on an enterprise.

Claim 57: Buchanan and Frank do not explicitly disclose allowing at least one organizational executive to track functionality and flag one or more of the at least one capability. Golightly discloses tracking and flagging capabilities (see at least ¶¶ 29-33 and 83). Furthermore, Examiner takes Official Notice that it was well-known in the art at the time the invention was made to flag areas of concern while tracking and monitoring performance. Thus, It would have been obvious to one of ordinary skill in the art at the time the invention was made to flag certain capabilities while tracking and monitoring performance as disclosed by the cited references. One of ordinary skill in the art would have been motivated to do so for the benefit of efficiencies gained by closely monitoring areas of concern.

Claim 58: Buchanan discloses using the assigned weight to make a decision based on one or more of the implementation cost, the revenue increase, and the cost saving (see page 3, paragraph 3; page 7, paragraphs 1-2).

Claim 59: Buchana discloses providing the user with a plurality of dynamic links to operational elements of the system (see page 2, paragraph 3, disclosing a hierarchy that extends from the business strategy level to the IT implementation level and allows the organization to align business goals and IT investment plans; figure 3, depicting a business process that is linked to overall strategy and is supported by an application and technology infrastructure within a value chain; page 6, paragraphs 3-4, disclosing linking technology to program/project initiatives and defining relationships between processes and infrastructure; figures 4 and 5, depicting linking different levels of the enterprise architecture; Examiner's note: Frank also discloses this limitation – see figure 4). The cited references do not disclose every one of the claimed links. However, the claimed links amount to non-functional data such as a mere arrangement of data. Such nonfunctional descriptive material is not given patentable weight absent a new and unobvious functional relationship between the nonfunctional matter and the substrate. *In re Gulack*, 703 F.2d 1381, 1385 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 1583-84 (Fed. Cir. 1994); MPEP 2106.01. Where the only difference between the prior art product and the claimed invention is printed matter that is not functionally related to the product, the content of the printed matter will not distinguish the claimed product from the prior art. *In re Ngai*, 367 F.3d 1336, 1339 (Fed. Cir. 2004); MPEP 2112.01(III).

Claim 60: Buchanan and Frank do not explicitly disclose storing updates to the database dynamically as changes are made to the hierarchical relationship. Golightly discloses this limitation (see abstract). Furthermore, Examiner takes Official Notice that it was well-known in

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the art at the time the invention was made to save updates to a database when changed are made. It would have been obvious to one of ordinary skill in the art at the time the invention was made to save the models of Buchanan and Frank to a database as they are changed according to the disclosure of Golightly and the knowledge of one of ordinary skill in the art. One of ordinary skill in the art would have been motivated to do so for the benefit of efficiencies gained by storing the correct and most recent versions of documents.

Claim 61: Buchanan discloses using the system to transition the at least one capability into actual operations (see page 1, paragraph 1, disclosing implementing new solutions quickly).

Claim 62: Buchanan discloses determining whether the at least one capability supports and satisfies a customer value (see page 1, paragraph 3, disclosing aligning projects with goals; page 2, paragraphs 2-3; page 3, paragraph 3, disclosing valuing investments; page 7, paragraphs 1-2).

Claim 63 is rejected under 35 U.S.C. 103(a) as being unpatentable over Buchanan, Frank, and Golightly, and further in view of Chalmeta, "References Architectures for Enterprise Integration."

Claim 63: The cited references do not explicitly disclose conducting a tradeoff analysis and a business case analysis, the tradeoff analysis being based on a cost, a time factor, and a benefit. Chalmeta discloses this limitation (see page 188: column 1: paragraph 2, disclosing a cost/benefit analysis and meeting physical requirements; page 190: section 12, disclosing

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decision support systems; page 183: column 2: item 3, disclosing sorting priority of short, medium, and long term projects). It would have been obvious to one of ordinary skill in the art at the time the invention was made to conduct a tradeoff analysis as disclosed by Chalmers when considering the investment decisions disclosed by Buchanan. One of ordinary skill in the art would have been motivated to do so for the benefit of selecting the most effective and efficient projects to implement.

(10) Response to Argument

Appellant argues the following:

- (A) The cited references do not teach "capturing and displaying current resources of the organization and how they relate to the organization's mission in real time." (See Brief, pages 10-15 and 20-21).
- (B) The cited references do not teach "illustrating and quantifying a value of transforming an enterprise business model of the organization from a current "as-is" state to a proposed "to-be" business model." (See Brief, pages 15-17 and 21-23).
- (C) The cited references do not teach "defining the goal as a corporate directive establishing a final end point of an enterprise change." (See Brief, pages 17-18 and 24-25).

Appellant's arguments will now be addressed in turn.

(A) The cited references do not teach "capturing and displaying current resources of the organization and how they relate to the organization's mission in real time." (See Brief, pages 10-15 and 20-21).

Regarding argument (A), Examiner respectfully disagrees. First, Buchanan discloses this limitation. The enterprise architecture disclosed by Buchanan "identifies (in a very targeted, pragmatic way) which assets will engage in what processes in support of the forward business strategy . . . [and] . . . decomposes the enterprise's business strategies, the assets and processes required to execute them, as well as their impact on business functions." (See page 5: paragraphs 3 and 4). Thus, Buchanan discloses capturing assets (i.e. the claimed resources) of an organization and their relation to the organization's strategy (i.e. the claimed mission). The enterprise architecture of Buchanan is also an "ongoing process" that is "constantly being refined or revised" and thus is performed in the claimed "real time." (See page 3: paragraph 1; page 2: paragraph 2: "insure that IT projects routinely support[] corporate goals"). Finally, Buchanan discloses the claimed "displaying" by modeling the enterprise architecture. (See page 5: paragraph 4; page 10: figure 6, depicting modeling enterprise architectures). Thus, Buchanan discloses the claimed limitation.

Furthermore, Frank discloses the claimed limitation. In the upper-left quadrant of figure 4, Frank depicts resources (including technology, human resources, and financial resources) that are used by organizational activities to drive the enterprise strategy. (See also figure 3, depicting a resource (an insurance broker) and its relationship to organizational operations, which drive the organization's strategy through a value chain; "MEMO SML" section on pages 5-6). This information is displayed in a model. (See abstract, disclosing visual modeling languages for

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describing corporate strategies, business processes, resources, and information; page 2: column 1: paragraph 2, disclosing "graphical models"; page 2: column 1: paragraph 3: "The basic idea is to model different views on a company . . ."; page 2: column 1: paragraph 4: "MEMO . . . is a method for enterprise modeling . . . that offers a set of specialized visual modelling languages . . ."; page 2: column 2: section 2: paragraphs 1-2, disclosing visualization and graphical representation of models; the reference discloses such visualization and graphical modeling throughout). Thus, Frank discloses the claimed limitation.

(B) The cited references do not teach "illustrating and quantifying a value of transforming an enterprise business model of the organization from a current "as-is" state to a proposed "to-be" business model." (See Brief, pages 15-17 and 21-23).

Regarding argument (B), Examiner respectfully disagrees. Buchanan discloses this limitation. For example, on page 7, Buchanan discloses: "Any change in principles or in models results in an analysis of the gap between what already exists and what is called for by the changed strategy and the redefined enterprise architecture." Thus, Buchanan discloses analyzing the claimed enterprise business model from a current "as-is" state (in Buchanan, "what already exists," above) to a proposed "to-be" business model (in Buchanan, "what is called for," above). Buchanan discloses analyzing the gap between the current state and a future state of a business (see page 7, cited above; page 5, disclosing current and future state models; page 2: paragraph 3, disclosing identifying the gaps between the current state and the future architecture). Buchanan also discloses quantifying a value of the transition between current and future states. (See page

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7: "Based on values and priorities assigned to requirements and principles, IT is in a position to create a set of priorities for modifications and to plan changes. . . . IT investments are made according to objective measures of business strategic value and in accordance with a long term plan for infrastructure and architecture development."; page 3, disclosing using value measures to guide decisions).

Appellant's main contention is that Buchanan fails to disclose "illustrating" the value determined via gap analysis. (See Brief, page 16). However, Buchanan discloses "illustrating" via modeling the enterprise architecture. (See page 5: paragraph 4, disclosing modeling current and future states, including decomposing strategies, the assets and processes required to execute them, and **their impact on business functions**; page 10: figure 6, depicting modeling enterprise architectures; figure 5 on page 7). Furthermore, even if Buchanan did not explicitly disclose "illustrating" the determined value, this limitation would not make the claimed invention allowable over the prior art. It would be incredibly obvious on its face for one of ordinary skill in the art to display (or "illustrate") the claimed values to increase the ease of comparison. Thus, the claimed limitation is taught in the prior art.

(C) The cited references do not teach "defining the goal as a corporate directive establishing a final end point of an enterprise change." (See Brief, pages 17-18 and 24-25).

Regarding argument (C), Examiner respectfully disagrees. First, Buchanan discloses this limitation. Buchanan discloses goals as corporate directives to make changes in a company's strategies. (See page 5: paragraph 2: "Once new opportunities and threats are identified, the

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strategy and planning group must decide if they warrant changes in the company's strategies.

This results in a new or refined business vision, which in turn, results in a new business strategy."; page 6: final paragraph: "the goal is . . . to concentrate on those aspects of the business that will need to be changed in order to deliver the new corporate values and priorities).

Buchanan also discloses corporate goals in the context of bridging the gap between current and future organizational states. (See page 2: paragraphs 2-3; page 3: paragraph 3, disclosing goals of financial efficiency and business effectiveness; page 5: paragraphs 3-4, disclosing determining how to achieve corporate goals; page 7: paragraphs 1-2, disclosing analyzing the gap between current and future states as required by changed strategies). Thus, Buchanan discloses the claimed limitation

Second, Frank discloses this limitation. Frank is directed to modeling languages that aid an enterprise in redesigning its processes and strategies. In other words, Frank teaches goals that include establishing a final end point of enterprise change (such as a redesigned process or strategy). (See page 1: Introduction, disclosing "business redesign," "business process redesign," and "redesigning a corporate strategy"; see also abstract, disclosing "organizational changes"; page 3: section 3.2, disclosing redesigning core business processes). Thus, Frank discloses the claimed limitation.

Finally, Examiner notes that Appellant has merely applied an old and well-known definition to the term "goal." A "goal" is synonymous with a "result," "aim," or "end," and necessarily involves some change from the current state. Thus, it is inherent (or at least strongly implied) that a corporate goal is "a final end point of an enterprise change." Examiner has shown above that Buchanan and Frank both explicitly disclose the claim limitation; however, even if

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they did not, they also impliedly teach this limitation because they repeatedly discuss corporate goals.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

Conclusion

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Neil R. Kardos/

Examiner, Art Unit 3623

/Beth V. Boswell/

Supervisory Patent Examiner, Art Unit 3623

Conferees:

/Jonathan G. Sterrett/

Primary Examiner, Art Unit 3623

Beth V. Boswell /bvb/

Supervisory Patent Examiner, Art Unit 3623

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